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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/617,209  | 07/11/2003  | Shiro Hayashi        | 116514              | 3113             |
| 25944   | 7590        | 02/16/2005           | EXAMINER            |                  |
| OLIFF & BERRIDGE, PLC<br>P.O. BOX 19928<br>ALEXANDRIA, VA 22320 |             |                      | WATKO, JULIE ANNE   |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |

2653

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/617,209

Applicant(s)

HAYASHI, SHIRO

Examiner

Julie Anne Watko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 7-13 is/are rejected.
- 7) ☒ Claim(s) 2-6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 04/29/04, 10/28/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
2. Applicant cannot rely upon the foreign priority papers to overcome any rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

### ***Drawings***

3. Figure 7 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
5. The disclosure is objected to because of the following informalities:

On page 15, line 3, the specification recites "Figs. 4 and 5". This is inconsistent with the appearance of Figs. 4A-B and 5A-C.

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On page 12, line 15, the specification recites "Fig. 2". On page 12, line 24, the specification recites "Fig. 2". On page 13, line 21, the specification recites "Fig. 3". These recitations are inconsistent with the appearance of Figs. 2A-B and 3A-D.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

7. Claims 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Toshiba (JP 8-249852).

As recited in independent claim 12, Toshiba shows a disk cartridge (see Fig. 21) which accommodates an information-recording disk 6 and which is inserted into an information-recording/reproducing apparatus to record and/or reproduce information, the disk cartridge comprising: an upper case 1 and a lower case 2 each of which has an opening (4a and 4b) for inserting a spindle and a head of the information-recording/reproducing apparatus, the opening being formed over a region ranging from a central portion of the disk cartridge to an end of the disk cartridge, wherein: the upper case and the lower case are openable/closable by a hinge 51 with engaging sections (see overlapping walls of 1 and 2 at front half) for maintaining a closed state being provided at least at two positions on a side opposite to the hinge as viewed from a center of the disk cartridge; and end portions which are defined by the opening and which are disposed at an end of the disk cartridge are connected by a bridge (see Fig. 21).

As recited in claim 13, Toshiba shows that the information-recording disk 6 accommodated in the disk cartridge (see Fig. 21).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toshiba (JP 8-249852) in view of Taguchi et al (US PAP No. 2002/0185393 A1).

As recited in independent claim 1, Toshiba shows a disk cartridge (see Fig. 21) which accommodates an information-recording disk, the disk cartridge comprising: an upper case 1 which has a first engaging section (wall of 1 at front half); a lower case 2 which has a second engaging section (wall of 2 at front half) engageable with the first engaging section and which defines a disk-accommodating section (in which 6 is located) when the lower case overlaps with the upper case; and a movable section (see 51) which is provided for the upper case and/or the lower case and which rotates the upper case relative to the lower case, an opening 4a is provided on at least one of surfaces of the upper case and the lower case, and at least a pair of parallel flat sections (see Fig. 21, which shows a rectangular case having plural pairs of parallel flat sections).

As recited in claim 1, Toshiba does not show that each of the upper case and the lower case is formed to be substantially circular while having at least a pair of parallel flat sections disposed at opposing positions on an outer circumference.

As recited in claim 1, Taguchi et al teach a disk case (see Fig. 1) substantially circular (“necessarily almost a circle”, see ¶ 0054) while having at least a pair of parallel flat sections 2i disposed at opposing positions on an outer circumference.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Toshiba with the shape of Taguchi et al as taught by Taguchi et al. The rationale is as follows: one of ordinary skill in the art would have been motivated to provide the case with the shape in order to decrease an area of the disk case, so as to downsize a drive as taught by Taguchi et al (see ¶ 0055-0056) and to avoid mounting the case in a mistaken mounting orientation as taught by Taguchi et al (see ¶ 0053).

As recited in claim 7, Toshiba shows that the opening 4a is open so that an information-recording surface and a central portion of the information-recording disk 6 are exposed (see Fig. 21).

As recited in claim 8, Toshiba shows a bridge (see Fig. 21) which is provided at an end of each of the upper case and the lower case on a side on which the opening is formed.

As recited in claim 9, Toshiba is silent regarding the thickness of the bridge; however, it is well established that there is no invention in altering the dimensions of a prior art product, absent some unexpected results due to the claimed dimensions.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have had the case of Toshiba satisfy the relationships set forth in claim 9. The rationale is as follows: one of ordinary skill in the art would have been motivated to have had the case of Toshiba satisfy the relationships set forth in claim 9 since it is notoriously old and well known in the art to routinely modify a case structure in the course of routine optimization /experimentation and thereby obtain various optimized relationships including those set forth in claim 9. Moreover, absent a showing of criticality (i.e., unobvious or unexpected results), the relationships set forth in claim 9 are considered to be within the level of ordinary skill in the art.

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Additionally, the law is replete with cases in which when the mere difference between the claimed invention and the prior art is some range, variable or other dimensional limitation within the claims, patentability cannot be found.

It furthermore has been held in such a situation, the Applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Moreover, the instant disclosure does not set forth evidence ascribing unexpected results due to the claimed dimensions. See *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), which held that the dimensional limitations failed to point out a feature which performed and operated any differently from the prior art.

Regarding claim 10: The product by process limitations in these claims (e.g. “formed by integrated formation”) are directed to the product per se, no matter how actually made, *In re Hirao*, 190 USPQ 15 at 17 (footnote 3). See also *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Fessman*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wertheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); *In re Marosi et al*, 218 USPQ 289; and particularly *In re Thorpe*, 227 USPQ 964, all of which make it clear that it is the patentability of the final structure of the product “gleaned” from the process limitations or steps, which must be determined in a “product by process” claim, and not the patentability of the process limitations. Moreover, an old or obvious product produced by a new method is not a patentable product, whether claimed in “product by process” claims or not. Note that the applicant has the burden of proof in such cases, as the above case law makes clear.

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Furthermore, regarding the limitation “integrated”, it is noted by the Examiner that the term is interpreted broadly, and is not limited to single-piece construction. See *In re Larson*, 144 USPQ 347 (CCPA 1965).

As recited in claim 11, Toshiba shows information-recording disk 6 in the disk cartridge (see Fig. 21).

#### ***Allowable Subject Matter***

10. Claims 2-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Berkson et al (US Provisional Application 60428151) show a safety case for single-hand deployment and retrieval of compact discs and CD-ROMs, and teach that “contrasting appearances of the rounded back 15 and the straight frontal opening 14 aid in distinguishing the back of the case from the front. This is important because it eliminates use of the trial-and-error method associated with ascertaining which side of a traditional CD case opens. The rounded back 15 also allows for easier handling of the case” (see page 4, line 27-page 5, line 4). Berkson et al (US PAP No. 2004/0107432 A1) claim priority to provisional SN 60428151.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR



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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Anne Watko whose telephone number is (703) 305-7742.

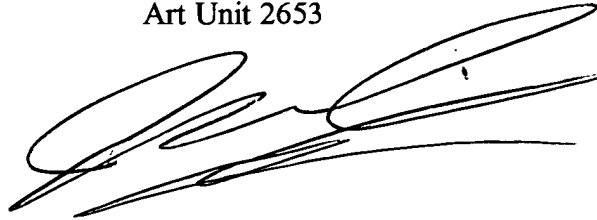
The examiner can normally be reached on Tues. & Thurs. until 9PM, Wed. & Fri. until 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703)305-6137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Julie Anne Watko  
Primary Examiner  
Art Unit 2653

February 15, 2005

JAW

A handwritten signature in black ink, appearing to read 'Julie Anne Watko', with a stylized, flowing script.